

Application No. 10/559,097
Amendment dated December 11, 2010
In Reply to Office Action of October 13, 2010
Attorney Docket No. 4559-053584

REMARKS

This Amendment is in response to the Final Office Action dated October 13, 2010. The Finality of the Action is requested to be withdrawn by this prompt Amendment for the reasons presented below, and in any case this Amendment places the case in condition for immediate allowance and certainly simplifies the issues remaining, if any at all, for resolution on Appeal. If any action is necessary prior to immediate allowance of the claims amended herewith, Applicant's representative Barbara E. Johnson, Esq. would very much appreciate a telephone call at 412-281-3350 direct dial.

Claims 22, 25, 28, 32 and 52 have been canceled herewith without prejudice. As the Examiner will appreciate, the new claims 54-61 parallel the canceled claims but are re-presented herewith as to format, with the added method step of confirming increased harvest index by 19% compared to corresponding nullizygous plants. Support for the amendatory language may be found, for example, at published paragraph 0112 of the specification, which reports test results for the seed-specific promoter PRO0090, as has already been established for example in Paragraph 3 of the February 8, 2010 Declaration of Dr. Valerie Frankard, PRO0090:CDS1608 is SEQ ID NO 2 operably linked to a seed-specific promoter. Previous claim 32 has been restyled as independent claim 55 in order to overcome the objections of the Examiner as to the improper dependent form of claim 32, and new claim 55 contains the requested recitation regarding temperature.

For the reasons explained below and the claims as amended herewith, each of the remaining issues in the Office Action dated October 13, 2010 may be seen to have been resolved. The list of rejections as having been withdrawn, in paragraphs 3-9 of the Office Action, is noted.

As alluded to above, the objection to claim 32 for improper dependent form has been corrected herewith by presenting the analogous recitations in an independent claim, namely, claim 55.

New claims 54-61 may be confirmed as nonobvious over Fukuda et al. and Wu et al. of record for reasons which include the following. In particular, the Examiner's concerns in the last full paragraph of page 5 of the October 13, 2010 Office Action may be seen as overcome as follows. The February 8, 2010 Declaration of Dr. Valerie Frankard is not intended to dismiss the possibility of practicing the invention (to be claimed, if at all, in a further divisional or

continuing application) with a specifically modified ubiquitin promoter, and the cancellation of claim language directed to such modified ubiquitin promoter during prosecution of this application is without prejudice to pursuing such claim language elsewhere. However, as set forth both in the specification and in Dr. Frankard's Declaration, and as now claimed, the use of the seed-specific promoter gives new and unexpected results in for example increasing the harvest index of plants in which the NHX expression is increased under non-salt-stress conditions. The method claims as pending now also provide for the affirmative selection step to select those plants that demonstrate the 19% increase in harvest index—which is to say, the selection will be of virtually all or all of the plants, but the step of so selecting is not taught or suggested by Fukuda et al. or Wu et al. even taken together. Not only in published specification paragraph 0112 is the increase in harvest index associated with the use of the PRO0090 seed-specific promoter shown to be new and unexpected (19%); as corroboration of this new and unexpected improvement in harvest index using the seed-specific promoter, Dr. Frankard's Declaration of February 8, 2010 presents data from a second seed-specific promoter (PRO0151) and the resulting increase in harvest index is 35%! Claims which require an already impressive increase of harvest index of 19% of course also embrace plants which demonstrate an increased harvest index of 35%. The use of root-specific promoter comparative results in the Dr. Frankard Declaration is for illustrative purposes only—to highlight the new and unexpectedly improved results with the seed-specific promoter—and is in no way inconsistent with the specification which identifies, as preferred embodiments of the invention, the use of either the seed-specific promoter or the modified ubiquitin promoter (see published specification paragraph 058, for example). If the Examiner has any further concern on this point, he is requested to call 412-281-3350.

Because neither Fukuda et al. nor Wu et al. appreciate even the possibility of improving harvest index by 19% by specifically choosing and using a seed-specific promoter as wielded in the claimed method, which also includes the selecting step, the asserted obviousness rejection over Fukuda et al. and Wu et al. may be seen to have been overcome. Absent consulting the present technology and patent specification, one skilled in the art would not have been able to select for plants having 19% increased harvest index as claimed and the commercial importance of a 19% increase is unquestionably significant and important.

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It is earnestly believed that the Examiner will now be satisfied that all remaining rejections and objections have been overcome. For the sake of completeness, however, the Finality of the October 13, 2010 Office Action should be noted as having been premature and the Finality should therefore be withdrawn (although allowance of claims 54-61 will moot the need for withdrawing the Finality of the Action). The claims at the time of the Request for Continued Examination were not drawn to the same invention claimed in the earlier application, namely, they were newly restricted to the seed-specific promoter embodiment simultaneously to the submission of the February 8, 2010 Dr. Valerie Frankard Declaration corroborating the new and unexpectedly improved results achievable with the seed-specific promoter limitation in particular. Because the claims were not drawn to the same invention as claimed in the earlier application, the first Action after a Request for Continued Examination ought to have been a first and nonfinal Action. Allowance of claims 54-61 submitted herewith will, as stated above, moot the need to withdraw the Finality of the October 13, 2010 Office Action and such allowance is respectfully requested.

CONCLUSION

Claims 54-61 are now in condition for allowance. Should any issue remain at all, the undersigned respectfully requests a telephone call to her direct dial number, 412-281-3350.

Respectfully submitted,

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